



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,219	04/26/2001	Shunpei Yamazaki	12732-032001 / US4867	5375

26171 7590 05/05/2005

FISH & RICHARDSON P.C.  
1425 K STREET, N.W.  
11TH FLOOR  
WASHINGTON, DC 20005-3500

EXAMINER
----------

HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
----------	--------------

2131

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/842,219

Applicant(s)

YAMAZAKI ET AL.

Examiner

Matthew T. Henning

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,26,51 and 54-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,26,51 and 54-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/18/05, 1/11/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2131

This action is in response to the communication filed on 1/18/2005.

### **DETAILED ACTION**

1. Claims 1, 26, 51, and 54-82 have been examined. Claims 2-25, 27-50, and 52-53 have been cancelled.

2. All objections and rejections not set forth below have been withdrawn.

#### ***Title***

3. The title of the invention is acceptable.

#### ***Priority***

4. The application has been filed under Title 35 U.S.C §119, claiming priority to Japanese application 2000-126513, filed April 26, 2000.

5. The effective filing date for the subject matter defined in the pending claims in this application is April 26, 2000.

#### ***Information Disclosure Statement***

6. The information disclosure statements (IDS) submitted on 04/26/2001, 1/11/2002, 3/07/2002 and 1/18/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

#### ***Drawings***

7. The drawings filed on 04/26/2001 are acceptable for examination proceedings.

#### ***Specification***

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

*The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means"*

Art Unit: 2131

*and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.*

*The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.*

The abstract as amended is objected to because it less than 50 words and therefore does not meet the length requirement for the Abstract of the Disclosure.

Appropriate correction is required. See MPEP § 608.01(f).

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 56, 68 and 79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 56 and 68 both recite the limitation "the information" but both claims fail to point out which information is being referred to by the claim. Both parent claims recite three types of information, "stored biological information", "read biological information" and "information that the read...have matched". The ordinary person skilled in the art would be unable to determine which information was being referred to by claims 56 and 68, and as such would be unable to determine the scope of the claim. Therefore claims 56 and 68 are rejected under 35 USC 112 2<sup>nd</sup> Paragraph for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

12. Claim 79 recites the limitation "the palm pattern" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

14. Claims 1, 26, 51, 54-60, and 62-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li.

15. Regarding claims 1 and 26, Li disclosed a portable communication device having a system for identifying an individual to identify a client (See Li Abstract), said portable communication device comprising: a memory for storing at least one reference biological information of the client (See Li Fig. 4 Element 404, Col. 10 Lines 57-65) and Col. 12 Lines 20-27); a sensor for reading at least one biological information of the client (See Li Fig. 4 Element 417); a checking circuit for checking the read biological information with the stored biological information (See Li Fig. 4 Element 401 and Col. 12 Lines 8-36); a transmitting circuit for transmitting information that the read biological information and the stored biological information have matched to a server in a case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9).

Art Unit: 2131

16. Regarding claim 51, Li disclosed a business method using the Internet, said business method comprising: identifying a client by an identifying element loaded in a portable communication device (See Li Fig. 1 Elements 101, 102, and 112 and Fig. 4); and controlling a communication between the client and a plurality of dealers (See Li Fig. 2 Element 202) by a control element in a server (See Li Abstract, and Figs. 3A and 3B); wherein said identifying comprises: storing a reference biological information of the client's (See Li Fig. 4 Element 404 and Col. 10 Lines 57-65 and Col. 12 Lines 20-27); reading biological information of the client (See Li. Col. 10 Lines 57-58); checking the read biological information with the reference biological information (See Li Col. 10 Lines 61-65) ; and transmitting information that the read biological information and the reference biological information have matched from the identifying element to the control element in a case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9), and wherein said controlling step comprises: admitting the communication between the client and the plurality of dealers after identifying the client by the identifying element (See Li Col. 11 Lines 19-60); and providing a password to the client (See Li Col. 10 Lines 48-56).

17. Regarding claims 54 and 66, Li disclosed that the memory stores a plurality of biological information of the client (See Li Col. 15 Paragraph 3 and Col. 3 Paragraph 3 and Col. 10 Paragraph 4), and the transmitting circuit transmits information that the read biological information has matched with at least one of the stored plurality of information to the server (See Li Col. 11 Lines 3-9).

18. Regarding claims 55 and 67, Li disclosed that the sensor reads a plurality of biological information of the client (See Li Col. 15 Paragraph 4), and the transmitting circuit transmits

Art Unit: 2131

information that each of the plurality of read biological information has matched with at least one of the plurality of stored biological information (See Li Col. 11 Lines 3-9).

19. Regarding claims 56 and 68, Li disclosed that the information is transmitted to the server through the Internet (See Li Col. 7 Paragraph 2).

20. Regarding claims 57 and 71, Li disclosed that after transmitting information that the checking has matched to the server, a personal identification number information is sent to the Server (See Li Col. 15 Paragraphs 3-4).

21. Regarding claims 58 and 72, Li disclosed that in a case that the personal identification number matches with a number stored at the server, the stored biological information is rewritable (See Li Col. 15 Paragraph 3).

22. Regarding claims 59-60, 73-74, and 78-79, Li disclosed that the biological information is one selected from the group consisting of a fingerprint, a palm pattern and a voice print; and that the palm pattern is a whole pattern of the palm or a pattern of a part of the palm (See Li Col. 6 Paragraph 3 and Col. 17 Paragraph 3).

23. Regarding claim 62, Li disclosed that the sensor includes one of a photodiode and a CCD (See Li Col. 4 Paragraph 6).

24. Regarding claims 63-65, 75-77, and 80-82, Li disclosed that the portable communication device comprises a portable information terminal; a portable telephone; a personal computer (See Li Col. 5 Line 66 – Col. 6 Line 14).

Regarding claims 69-70, Li disclosed a step of transmitting information that the checking has matched from the server to a connection of the client; and that a transaction is started

Art Unit: 2131

between the client and the connection after the connection has received information that the checking has matched (See Li Col. 16 Paragraph 2).

***Claim Rejections - 35 USC § 103***

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li as applied to claim 1 above, and further in view of Osborn (US Patent Number 6,026,293).

Li disclosed a memory unit containing programs, responses and any other information the Fingerprint Capturing Module of the cellular phone needed to operate (See Li Col. 12 Lines 20-27), but failed to disclose what type of memory the memory unit was.

Osborn teaches that in cellular telephones, programs are stored in flash memory (See Osborn Col. 3 Line 61 – Col. 4 Line 2).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Osborn in the authenticating cellular telephone of Li by providing the memory unit as a flash memory. This would have been obvious because the ordinary person skilled in the art would have been motivated to store the programs of the phone in the conventional manner.

***Response to Arguments***

27. Applicant's arguments filed 1/18/2005 have been fully considered but they are not persuasive. Applicant's argue primarily that:



Art Unit: 2131

- i. Pare, Jr. did not disclose the use of a portable communication device.
- ii. Li did not disclose a portable communication device that identifies a client because the reference biological information is stored in a central authentication system and is not loaded into the cellular telephone.

28. Applicant's arguments i., with respect to claims 1 and 26, have been considered but are moot in view of the new ground(s) of rejection.

29. Regarding applicant's argument ii., that Li did not disclose a portable communication device that identifies a client because the reference biological information is stored in a central authentication system and is not loaded into the cellular telephone, the examiner has considered the argument and does not find it persuasive. This is due to the fact that Li does disclose the an identifying unit in a phone identifying a client (See Li Col. 10 Line 57 – Col. 11 Line 9 and Col. 3 Paragraph 1 and Page 9 Line 27 – Page 10 Line 2 of the response by applicant filed 1/18/2005). Li clearly disclosed the central authentication system sending (loading) the reference biological token into the phone where the phone compares the reference token to the token created it the phone from the users captured biometric information. Therefore, the argument persuasive and has maintained the rejections presented above.

30. Furthermore, as recited above, Li disclosed storing all information necessary to the operation of the Fingerprint Capturing Module in the Memory Unit (See Li Col. 12 Lines 20-27). Li also disclosed that the Fingerprint Capturing Module performed the comparison between the captured token and the received reference token (See Li Col. 10 Lines 57-65). Therefore, the FCPD needed the reference token to operate and therefore must have stored it in the Memory Unit.

*Conclusion*

31. Claims 1, 26, 51, and 54-82 have been rejected.

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. IBM TDB ("Palm Pilot for Credit/Debit/Cash Card with Biometric Authentication") disclosed a method for authenticating transactions using a palm pilot with biometric authentication capabilities.
- b. Ruell (U.S. Patent Number 4,532,508) disclosed a system for authenticating an individual using biometric data stored on a portable medium.
- c. Drexler et al. (U.S. Patent Number 5,412,727) disclosed a system for voting wherein the voter was authenticated through read biometric data compared to biometric data stored in an offsite database.
- d. Osten et al. (U.S. Patent Number 5,719,950) disclosed a biometric authentication system which multiple biometric devices verified different biometric characteristics simultaneously.
- e. Yu et al. (U.S. Patent Number 5,930,804) disclosed a web based biometric authentication system for authorizing access to various web servers.
- f. Ho (U.S. Patent number 6,021,212) disclosed a fingerprint authentication system for use with a computer in which the user was authenticated periodically via a biometric sensor on the mouse.
- g. Baumann (U.S. Patent Number) disclosed a communication system in which a mobile phone authenticated the user through biometric data of the user.

Art Unit: 2131

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

34. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2131

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew Henning  
Assistant Examiner  
Art Unit 2131  
4/20/2005



AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100